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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,973	05/30/2002	Robert C.U. Yu	D/A2002Q1	4060

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/063,973	Applicant(s) YU, ROBERT C.U.	
	Examiner Thao T. Tran	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This is in response to the Amendments received on March 09, 2004. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claims 1-8, 10-28 are currently pending in this application. Claim 9 has been canceled. Claims 27-28 have been newly added.

Election/Restrictions

3. Newly submitted claims 27-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 27-28 are directed to a method of use, whereas the originally claimed inventions are directed to an article and method of making.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-28 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Claim Rejections - 35 USC § 112

4. In view of the prior Office action of December 09, 2003, the rejection of claims 1- 26 are rejected under 35 U.S.C. 112, second paragraph, has been withdrawn due to the Amendments made thereto.

Claim Rejections - 35 USC § 102

5. Claims 1-8, 10-20, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al. (US Pat. 5,911,934), as evidenced by Rudolph et al. (US Pat. 3,989,655).

Yu '934 teaches a flexible imaging belt seam treatment article and a method of making, the method comprising providing a flexible web substrate and a charge transport layer (see abstract; Fig. 1; col. 1, ln. 11-24; col. 4, ln. 45-63; col. 8, ln. 12-17).

In regards to claims 1, 5-7, 10, 15, 16, 19, and 22, Yu '934 teaches providing a web substrate comprising a biaxially oriented PET film (see col. 8, ln. 12-19; col. 10, ln. 29-32); coating the surface of the substrate with a solution containing a thermoplastic polymer component (polycarbonate resin) and a charge transport compound; and drying the coated surface to form a film of the polymer component on the substrate (see col. 11, ln. 24).

Furthermore, with respect to the preambles in claims 1, 10, and 22, since the reference teaches all the structural elements and the steps involved in the method of making, as recited in the instant claims, what the reference teaches would be the same as the presently claimed invention.

In regards to claim 2, Yu '934 teaches the coated flexible substrate being cut into a strip (form a welded seam belt) (see col. 1, ln. 19-23). With respect to the use of the strip to cover the

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seam, it has been within the skill in the art that intended use would have no significant patentable weight.

In regards to claim 3, Yu '934 teaches the forming of a roll from the dried coated flexible substrate (see col. 11, ln. 34-37).

In regards to claims 4, 18, and 23, Yu '934 teaches the web substrate comprising a conductive layer of titanium (titanium coated biaxially oriented PET) (see col. 10, ln. 29-31).

In regards to claims 8-9, 11, Yu '934 teaches the coating solution further comprising a polycarbonate of Makrolon resin and N, N'-diphenyl-N, N'-bis(3-methylphenyl)-1,1'-biphenyl-4,4'-diamine as the charge transport compound in an organic solvent (methylene chloride) (see col. 11, ln. 13-29).

In regards to claims 5-6, 16-17, and 24, although Yu '934 does not specifically teach the substrate comprising a high glass transition temperature polymer film, since the reference teaches the substrate with the same polymer film (biaxially oriented PET film) as that in the presently claimed invention, the reference's polymer film would inherently have a high glass transition temperature.

In regards to claim 12, although Yu '934 does not specifically teach the thermoplastic polymer to be granular or powdered, the reference teaches the use of Makrolon polycarbonate, which has been known to be in pellet or powder form, as evidenced by Rudolph.

In regards to claims 13-14, Yu '934 teaches that the deposited coating is dried by air or by oven drying (see col. 7, ln. 50-53).

6. Claims 1-4, 7-8, 10-15, and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al. (US Pat. 6,117,603), as evidenced by Rudolph.

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Yu '603 teaches a flexible imaging belt seam treatment article and a method of making, the method comprising providing a flexible web substrate and a charge transport layer (see col. 1, ln. 33-35; col. 5, ln. 29-33).

In regards to claims 1, 4, 7-8, 10-11, 13-15, 18-19, and 22-23, Yu '603 teaches providing a web substrate comprising a metallic substrate (see col. 6, ln. 64 bridging col. 7, ln. 4); coating the surface of the substrate with a charge transport layer by applying a solution containing a thermoplastic polymer component (polycarbonate resin) and a charge transport compound in an organic solvent (methylene chloride); and drying the coated surface by air or baking (oven) to form a film of the polymer component on the substrate (see col. 10, ln. 8-40; col. 11, ln. 5-12).

With respect to the preambles in claims 1, 10, and 22, since the reference teaches all the structural elements and the steps involved in the method of making as recited in the instant claims, the reference would read on the presently claimed invention.

Furthermore, with respect to claims 1, 3, 10, 15, 22, and 23, although Yu '603 does not teach the substrate to high temperature resistant, since the reference teaches the same substrate (metallic material), the properties of the substrate, such as temperature resistance, would inherently be the same as the presently claimed invention.

In regards to claim 2, Yu '603 teaches the coated flexible substrate being cut into a strip (form a seamed belt) (see col. 6, ln. 19). With respect to the use of the strip to cover the seam, it has been within the skill in the art that intended use would have no significant patentable weight.

In regards to claim 3, Yu '603 teaches the forming of a roll from the coated flexible substrate (see col. 5, ln. 12-16).

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In regards to claims 9, 20-21, and 25-26, Yu '603 teaches the coating solution further comprising a bisphenol-A polycarbonate of Makrolon resin and N, N'-diphenyl-N, N'-bis(3-methylphenyl)-1,1'-biphenyl-4,4'-diamine as the charge transport compound in an organic solvent (methylene chloride) (see col. 10, ln. 39-40; col. 17, ln. 38-45).

In regards to claim 12, although Yu '934 does not specifically teach the thermoplastic polymer to be granular or powdered, the reference teaches the use of Makrolon polycarbonate, which has been known to be in pellet or powder form, as evidenced by Rudolph.

Response to Arguments

7. Applicant's arguments filed March 09, 2004 have been fully considered but they are not persuasive.

Throughout the Remarks, Applicants contend that the references of Yu differ from the presently claimed invention because the references do not teach a method of preparing a flexible imaging seam treatment article, such as the seam treatment or laminate strip. However, both references of Yu teach a method, comprising providing a flexible substrate 32 of a biaxially oriented PET film, coating a surface of the substrate with a solution including a polycarbonate and a charge transport compound in an organic solvent (bisphenol-A polycarbonate of Makrolon resin and N, N'-diphenyl-N, N'-bis(3-methylphenyl)-1,1'-biphenyl-4,4'-diamine as the charge transport compound in methylene chloride). Hence, the references of Yu do teach the presently claimed invention.

The recitation "a flexible imaging member seam treatment article" or "a flexible imaging member seam treatment strip" has not been given patentable weight because the recitation occurs

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in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

8. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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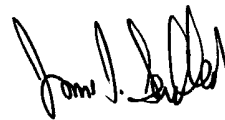
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 21, 2004



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